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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,102	04/16/2004	Yasuhiro Yoshioka	FS-F03338-01	7732

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EXAMINER

CHEA, THORL

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/825,102

Applicant(s)

YOSHIOKA, YASUHIRO

Examiner

Thorl Chea

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 04162004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 9-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to provide an adequate disclosure as how to form an image using a photothermographic material in the absence of first exposing to light.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by EP'1276007A1 (EP'007). See page 74-76, claims 1-27 and examples on pages 33-74; Table 1-8; the development accelerator on pages 43, 64. The invention as claimed is clearly anticipated by EP'007. The limitation (a), (b) is related to the material after processing. These properties fails to further differentiate the composition of the claimed material and that of the EP'007. There is no difference between the composition of the claimed material and that of EP'007. "product of

identical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if prior art teaches the identical chemical structure, the properties applicants disclosed and/or claims are necessarily present. In re Spada, 91 1 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)."

5. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Uytterhoeven et al (US Patent No. 6,143,488).

See Examples 1 in columns 13-14 and Table 2 in column 16 wherein the material contains silver behenate, silver iodide, binder, reducing agent (R01) and phthalazine compound. The invention as claimed is clearly anticipated by Uytterhoeven et al. The limitation (a), (b) is related to the material after processing. These properties fails to further differentiate the composition of the claimed material and that of Uytterhoeven et al. There is no difference between the composition of the claimed material and that of the prior art. "Product of identical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if prior art teaches the identical chemical structure, the properties applicants disclosed and/or claims are necessarily present. In re Spada, 91 1 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)." The phthalazine compound has been known in the art as development accelerator presented in the claims 3-4. The language such as the material is exposed using laser beam source in claims 5-8 is related to the use of the material in development process which fails to differentiate the claimed article form that of the applied prior art.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP'1276007A1 in view of Hirabayashi et al (US Patent No. 6,468,720). EP'30 on page 32, [0292] to [00297] discloses the process of developing the photothermographic material at development temperature from 80 °C to 250 °C for 1 to 60 second, but fails to disclose the line speed of 23 mm/sec or higher claimed in the present process. Hirabayashi et al in the abstract discloses to process of developing a heat development material at a transport speed of 22 mm to 40 mm/sec at temperature not less than 117 °C in not less than 10 sec. The process reduces variation of photographic performance and dimensional change, fluctuation in image density and dot percentage, and also enhances productivity. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the process taught in Harabayashi et al to develop the material of EP'310 with an expectation of reducing variation of photographic performance and dimensional change, fluctuation in image density and dot percentage, and also enhancing productivity, and thereby provide a process as claimed.

8. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uytterhoeven et al (US Patent No. 6,143,488) in view of Hirabayashi et al (US Patent No. 6,468,720). Uytterhoeven et al in column 11, lines 15-35 and column 13, lines 20-35 discloses the process of developing the photothermographic material at development temperature from 95 °C to 150 °C, but fails to disclose the line speed of 23 mm/sec or higher at the time for 12 second or less as claimed in the present process. Hirabayashi et al in the abstract discloses to process of developing a heat development material at a transport speed of 22 mm to 40 mm/sec

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at temperature not less than 117 °C in not less than 10 sec. The process reduces variation of photographic performance and dimensional change, fluctuation in image density and dot percentage, and also enhances productivity. It would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the process taught in Harabayashi et al to develop the material of Uytterhoeven et al with an expectation of reducing variation of photographic performance and dimensional change, fluctuation in image density and dot percentage, and also enhancing productivity, and thereby provide a process as claimed.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tchea *thc*  
June 9, 2005

*Thorl Chea*  
Thorl Chea  
Primary Examiner  
Art Unit 1752